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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/254,625 05/12/99 ESSER

H 16202.160

EXAMINER

IM22/1214

HAMPTON HIGHTOWER, F

ART UNIT

PAPER NUMBER

1711

DATE MAILED:

12/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/254,625

Applicant(s)
Hans-Peter Esser

Examiner
P. Hampton-Hightower

Group Art Unit
1711



☒ Responsive to communication(s) filed on May 12, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 5-8, and 13-17 is/are rejected.

☒ Claim(s) 3, 4, and 9-12 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Response to Amendment

The preliminary amendment filed May 12, 1999 is acknowledged.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-17 provide for the use of solvents for the manufacture and solutions for coating substrates and as an adhesive, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 13-17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a

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process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 5, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5 the expression "75°C" should have been --75°C--;

In claim 8, the expression "takes place" should have been --is performed--.

The terms "characterized by, take place, preferably" in claims 5, 7 and 8 are relative terms which renders the claim indefinite. The terms "characterized by, take place, preferably" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Higashi'376.

Higashi'376 discloses an aliphatic ester-amide copolymer can be dissolved in an organic solvent which has low toxicity and in the presence or absence of an inorganic metal salt which provides a solution that anticipates the claimed invention. See abstract; col. 2, lines 55-61; col. 3, lines 8-13, 25-26, 38-39, 44-45; col. 4, lines 10-44; col. 6, lines 22-35, 44-62; cols. 24-28.

The patentee teaches at col. 3, lines 8-13, 25-26, 38-39 that the low-toxicity organic solvents are **preferably aliphatic organic solvents, examples of which are aliphatic alcohols having 6 or less carbons such as methanol and ethanol; and that these aliphatic organic solvents may be used independently or optionally as a mixture thereof.**

The patentee teaches at col. 4, lines 10-44 the aliphatic organic solvent may contain water; and **the aliphatic ester-amide copolymer, when the content of amide units on the main chain thereof is from about 10 to about 80 mol%, preferably from about 10 to about 60 mol%, becomes an excellent resin which can exert the toughness of the aliphatic amide together with the good workability of the aliphatic ester and further can exert the biodegradability of the aliphatic polyester.**

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Higashi, Chiba and Timmermann are cited to show the state of the art of aliphatic polyesteramide copolymers.


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Facsimile Center

A facsimile center has been established in Technology Center 1700 Room CP3-8C10. The hours of operation are 8:45 am to 4:45 pm, Monday through Friday. The telecopier numbers for accessing the facsimile machine are **(703) 305-3599 for official after final faxes and (703) 305-5408 for all other official faxes.**

Any inquiry concerning this communication should be directed to **P. Hightower** at telephone number **(703) 308-2434.**

Hightower:phh
December 02, 1999


P. Hampton-Hightower
Primary Examiner
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